

REMARKS

The Official Action dated August 12, 2003 has been received and its contents carefully noted. In view thereof, claim 10 has been canceled without prejudice nor disclaimer of the subject matter set forth therein, and claims 9, 11, 12 and 18-22 have been amended in order to better define that which Applicants regards as the invention. Accordingly, claims 1-9 and 11-23 are pending in the instant application with claims 1-8 being withdrawn from further consideration by the Examiner.

Initially, Applicants wish to thank Examiner Passaniti for the courtesy extended to Applicants' representative during the personal interview conducted December 9, 2003 wherein the differences between the present invention and that of the cited prior art were discussed in detail. As indicated in the Interview Summary, the Applicants' representative noted that the claims would be amended to more specifically define the shaft orientation. As can be seen from the foregoing amendments, independent claim 9 has been amended in order to more specifically define the shaft orientation of the putter with respect to the continuous ball striking surface of the putter head. Reconsideration of the rejections of the record is earnestly solicited in view of the foregoing discussion during the personal interview as well as the remarks set forth herein and below.

Additionally, Applicants confirm their election without traverse of Group II (claims 9-23) directed to a golf putter or putting a golf ball.

Referring now to the Official Action, particularly page 3 thereof, claim 9 has been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,756,535, issued to Bradley. This rejection is respectfully traversed in that the patent to Bradley neither discloses nor remotely suggest that which is presently set forth by Applicants' claimed invention.

As can be seen from the foregoing amendments, independent claim 9 has been amended to recite a golf putter for putting a golf ball comprising an elongated putter head having a ball striking surface, a length of the putter head being greater than a width of the putter head with the ball striking surface being substantially cylindrical and extending around and parallel to a longitudinal axis of the putter head, the ball striking surface including an infinite number of ball striking lines extending parallel to said longitudinal axis of the putter head and continuing from

at least a lower surface of the putter head over an upper surface of the putter head, a flange secured to an extending along a length of the putter head, a shaft having a first end secured to the flange and extending upwardly from the flange and rearwardly of the ball striking lines, and a grip secured to a second end of the shaft. Clearly, the patent to Bradley neither discloses nor remotely suggest that which is presently set forth by Applicants' claimed invention.

As the Examiner can readily appreciate, the patent to Bradley fails to disclose nor remotely suggest the elongated putter head having a ball striking with a ball striking surface being substantially cylindrical and extending around and parallel to a longitudinal axis of the putter head. Accordingly, it is respectfully submitted that Applicants' claimed invention as set forth in independent claim 9 clearly distinguishes over the teachings of Bradley.

With reference to page 4 of the Office Action, claim 9 has also been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,267,689 issued to Ambrose. This rejection is likewise respectfully traversed in that the patent to Ambrose neither disclosed nor remotely suggests that which is presently set forth by Applicants' claimed invention.

Like the patent to Bradley, the patent to Ambrose fails to disclose or remotely suggest an elongated putter head having a ball striking surface with the ball striking surface being substantially cylindrical and extending around and parallel to a longitudinal axis of the putter head. Accordingly, it is respectfully submitted that Applicants' claimed invention as recited in independent claim 9 as amended clearly distinguishes over the teachings of Ambrose.

Continuing on page 4 of the Office Action, claims 10-19 and 21-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bradley in view of Drake. This rejection is respectfully traversed in that the requisite motivation for one or ordinary skill in the art to render Applicants' claimed invention obvious is not present. Moreover, the patent to Drake fails to overcome the aforementioned shortcomings associated with the patent to Bradley.

Again, as noted hereinabove, independent claim 9 which includes the limitations previously set forth in dependent claim 10 as well as additional limitations, recites a golf putter including an elongated putter head having a ball striking surface, with the ball striking surface being substantially cylindrical and extending around and parallel to a longitudinal axis of the putter head, the ball striking surface including an infinite number of ball striking lines extending

parallel to the longitudinal axis of the putter and continuing from at least a lower surface of the putter head over an upper surface of the putter head, a flange secured to and extending along a length of the putter head, a shaft having a first end secured to the flange and extending inwardly from the flange and rearwardly of the ball striking lines and a grip secured to a second end of the shaft.

In rejecting Applicants' claimed invention, the Examiner states that Bradley shows every feature claimed with the exception of a substantially cylindrical head and a flange that is longer than the length of the putter head. In this regard, it is noted that the patent to Bradley includes a head having a bottom face 15 that is substantially flat or planar and is adapted to be substantially parallel to the putting surface during a putting stroke. It further includes a substantially planar ball engaging face with a head including a recess 22 in the face behind the ball striking plate and slot 24 for receiving a wheel-like member 25 which is mounted on an axis in the putter head. Wheel-like member 25 is of a diameter such that the wheel-like member 25 extends a distance from the bottom face 15 of the putter head. This provides a skid that will engage the ground and thus permit the club to travel more easily relative to the ground when the bottom face 15 contacts the ground during a putting stroke.

The Examiner further notes that Drake shows that it is old in the art to provide either a substantially flat or substantially cylindrical ball striking club head and compares Figures 1-5 with Figures 6-10 of Drake. It is; however, noted that to provide the patent to Bradley with a cylindrical face as suggested by the Examiner would clearly destroy the essence of the patent to Bradley. Specifically, the lower surface of the putter head and the upper surface of the putter head of Bradley cannot include ball striking lines as is specifically recited by Applicants' claimed invention in that the wheel of the patent to Bradley must extend beyond the surfaces in order to function in the manner intended by Bradley. In doing so, the ball striking surface will be interrupted and such surfaces will not include ball striking lines as recited by Applicants' claimed invention.

Furthermore, as discussed during the personal interview, the patent to Drake specifically discusses in columns 2, lines 64 through column 3, lines 20, the orientation of the shaft with respect to the putter head. That is, the shaft is recited as being offset from the center line a

distance and range of about 1/16 to about 5/16 of an inch in order for the weighting of the head to be properly distributed with respect to the shaft. Furthermore, the Drake reference preferably includes an offset shaft which is inclined at an acute include an angle with respect to the longitudinal axis toward the front face of the head which contacts the ball. This again is done in order to provide a better feel to the user. Neither of these features are compatible with the teachings of Bradley nor are they consistent with Applicants' claimed invention. Furthermore, while the Examiner states that Drake simply notes that some golfers prefer the feel of a flat face to that of a rounded profile, which while possibly true, the same shortcomings associated with the round profile discussed hereinabove also apply to the flat face set forth in Figures 7-12 of the Drake reference. That is, therein the shaft is likewise preferable angled forward of the longitudinal axis of the putter head and likewise the balance achieved in doing so would be destroyed if combined with the teachings of Bradley. Additionally, if the shaft of the present invention were to extend into the plane of the ball striking lines, the intended purpose of the putter head configuration as discussed in detail in Applicants' specification would not be possible.

As the Examiner well knows, it is well settled that obviousness cannot be established by combining the teachings of prior art to produce the claimed invention, absence some teaching, suggestion or incentive supporting the combination, *In Re Geiger* 815 F.2d 686 (Fed. Cir. 1986), 2 USPQ2d 1276; 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Additionally, it also well settled that the mere fact that the prior art may be modified to reflect features of the claimed invention, does not make the modification, and hence the claimed invention, obvious unless the desirability of such modification is suggested by the prior art. That is, the claimed invention cannot be used as an **instruction manual** or **"template"** to piece together the teachings of the prior art so that the claimed invention is rendered obvious, *In Re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). Accordingly, while the Examiner states that it would have been obvious to modify the disclosure to Bradley with the teachings of Drake with the motivation made to accommodate the individual desires of each golfer with particular type of face configuration, this clearly is not sufficient requisite motivation particularly in that such modification destroys the essence of each of the respective disclosures.

Accordingly, it is respectfully submitted that the requisite motivation for combining the references in the manner suggested by the Examiner is nowhere to be found without resorting to Applicants' disclosure in that such combination clearly destroys the intended purpose of each of the noted disclosures and consequently, one of ordinary skill in the art would not be so motivated. Therefore, it is respectfully submitted that independent claim 9 as well as those claims which depend therefrom clearly distinguish over the combination proposed by the Examiner.

With reference now to page 5 of the Office Action, claim 20 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Bradley in view of Drake and the teachings of U.S. Patent No. 5,160,141 issued to Crews. This rejection is likewise respectfully traversed in that patent to Crews does nothing to overcome the aforementioned shortcomings associated with the combination of Bradley in view of Drake.

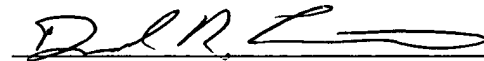
Initially, it is noted that claim 20 is directly dependent upon independent claim 9 and includes all limitations thereof. Accordingly, it is respectfully submitted that this claim is likewise in proper condition for allowance for the reasons discussed here and above. Moreover, while the patent to Crews may disclose providing a flange for connecting a shaft to the head of a putter with the thickness of the flange being less than that of the putter head, this reference clearly fails to disclose or suggest the critical shortcomings associated with the previous combination of references. Accordingly, it is respectfully submitted that claim 20 is likewise in proper condition for allowance.

Therefore, in view of the foregoing, it is respectfully requested that the rejections of record be reconsidered and withdrawn by the Examiner, that claims 9 and 11-23 be allowed and that the application be passed to issue.

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Should the Examiner believe a further conference would be of benefit in expediting the prosecution of the instant application, he is hereby invited to telephone counsel to arrange such a conference.

Respectfully submitted,



Donald R. Studebaker  
Registration No. 32,815

Nixon Peabody LLP  
401 Ninth Street, NW, Suite 900  
Washington, DC 20004  
Telephone: (202) 585-8000  
Facsimile: (202) 585-8080